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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/697,259	10/26/2000	Antulio Tarazona	99B140	3861

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EXAMINER

KRISHNAMURTHY, RAMESH

ART UNIT	PAPER NUMBER
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3753

DATE MAILED: 03/13/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/697,259

Applicant(s)

TARAZONA ET AL.

Examiner

Ramesh Krishnamurthy

Art Unit

3753

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 December 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 - 11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 - 11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 October 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Art Unit: 3753

This office action is responsive to communications filed on 12/04/01.

Claims 1 – 11 are pending.

1. Inasmuch as the words "improved," "improvement of," and "improvement in" are not considered as part of the title of an invention, the Patent and Trademark Office does not include these words at the beginning of the title of the invention. See MPEP § 606.01.

2. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The following title is suggested: ***Magnet operated check valve.***

3. The abstract of the disclosure is objected to because of the use of legal phraseology such as "means". Correction is required. See MPEP § 608.01(b).

4. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the claimed electromagnet (Claims 4 and 8) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

5. Claim 1 is objected to because of the following informalities: It appears that in line 1, "space" needs to be replaced with - - spaced - -. Appropriate correction is required.

6. Claim 8 is objected to because of the following informalities: it appears that in line 1 "uncorporated" needs to be replaced with - - incorporated - -. Appropriate correction is required.

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 1 – 11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

9. Claim 1 recites the limitation "the valve stem assembly" in line 7. There is insufficient antecedent basis for this limitation in the claim.

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. Claims 1 – 3, 5, 7, 9 and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Brown.

Brown discloses a valve comprising a housing (20) having an inlet (26) and an outlet formed near a seat (32) for a valve member (40) having a sealing pad (42) that engages the seat (32). A pair of permanent magnets (46) and (60) provide the required force to close the valve, with the magnet (46) located adjacent the seat (32). The seat (32) is a lower portion of a sleeve (24) that is secured to a cap (22). A polymeric bush (64) is also provided.

Art Unit: 3753

12. It is well settled that the law of anticipation does not require that the reference teach what appellant is teaching or has disclosed, but only that the claims "read on" something disclosed in the reference, i.e. all the limitations of the claim are found in the reference. See Kalman v. Kimberly Clark Corp. 713 F.2d 760, 218 USPQ 781 (Fed. Cir. 1083). Moreover, it is not necessary for the applied reference to expressly disclose or describe a particular element or limitation of a rejected claim word for word as in the rejected claim so long as the reference inherently discloses that element or limitation. See Standard Havens Products Inc. v. Gencor Industries Inc., 953 F.2d 1360, 21 USPQ 2d 1321 (Fed. Cir. 1991).

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

15. Claims 4 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brown.

The patent to Brown discloses the invention claimed with exception of having an electromagnet either adjacent to the valve seat or in the cap. However use of an electromagnet in valves is well known in the art and additionally, the use of electromagnets allows the control of the valves from outside either automatically or through an operator. The use of an electromagnet would have been obvious to one of ordinary skill in the art since the use of electromagnets allows the control of the valves from outside either automatically or through an operator.

16. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Brown.

The patent to Brown discloses all the claimed features with the exception of having a spherical sealing pad. However to provide a spherical sealing pad is considered to be an obvious design expedient over those features disclosed by Brown in that it neither solves any stated problem nor provides any new and / or unexpected result.

17. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Brown as applied to claims 1 – 3, 5, 7, 9 and 11 above, and further in view of Tischer et al..

The patent to Brown discloses all the claimed features with the exception of having a shock absorber. The patent to Tischer et al. discloses that it is known in the art to employ a shock absorber (50) for the purpose of reducing or eliminating the noise within the valve assembly resulting from the impact during seating of the valve. It would have been obvious at the time the invention was made to a person having ordinary skill

in the art to employ in Brown a shock absorber for the purpose of reducing/eliminating impact noise as recognized by Tischer et al..

18. The courts have concluded that there is no requirement that a motivation to make the modification be expressly articulated. The test for combining references is what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art. In re McLaughlin, 170 USPQ 209 (CCPA 1971). Also references are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures. In re Bozek, 163 USPQ 545 (CCPA 1969).

19. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Bullard discloses an adjustable magnetic pressure valve. Blackford discloses a laminated magnetic rubber valve. Raimondi et al. discloses a reciprocating magnetic check valve. Shimizu discloses a magnetically operated fluid shut-off device. Morris et al. and Jacobs disclose magnetically operated check valves.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ramesh Krishnamurthy whose telephone number is (703) 305 - 5295. The examiner can normally be reached on Monday - Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael P. Buiz, can be reached on (703) 308 - 0871. The fax phone number for the organization where this application or proceeding is assigned is (703) 308 - 7765.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308 - 0861.

Ramesh Krishnamurthy, Ph. D., PE
Examiner
Art Unit 3753
March 10, 2002



Michael P. Buiz
Supervisory Patent Examiner
US Patent & Trademark Office

3/11/02